

Remarks/Arguments

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. By the present amendment, claims 1 and 6 are amended, claims 3 and 4 are canceled, and claim 17 is added. Claims 1, 5-14, and 17 are currently pending. Claim 6 is amended to remove language related to screwing together the outer and inner threads in order to overcome the rejection under 35 U.S.C. 112.

Claims 1, 3-9 and 12-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,530,355 to Griggs ("Griggs"). Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Griggs in view of U.S. Patent No. 6,592,587 to Roger. Withdrawal of these rejections is respectfully requested for at least the following reasons.

Claim 1 is amended to include the subject matter of claim 4. It is respectfully submitted that claim 1 patentably defines over Griggs for at least the following reasons.

The allegation of the examiner that "as long as the prior art structure is capable of a recited use, it reads on the claimed invention" does not fulfill the requirement of anticipation. In In re Robertson, 169 F.3d 743, 49 USPQ2d (Fed. Cir. 1999), the Federal Circuit reversed an anticipation holding because the prior art was only capable of being modified and one of ordinary skill would not have recognized such modification. As stated by the Federal Circuit In re Robertson, "The Board's theory that these two fastening devices in Wilson were *capable of* being intermingled

to perform the same function as the third and first fastening elements in claim 76 is insufficient to show that the latter device was inherent in Wilson”.

Moreover, it is respectfully submitted that functional language in a claim must be considered. The Court of Customs and Patent Appeals in In re Land gave patentable weight to functional portions of claims by stating that the court does not regard the fact that portions of a claim are functional as a good ground to give them “no weight”. In re Land, 151 USPQ 621 (C.C.P.A. 1966). Furthermore, the Court of Appeals for the Federal Circuit in In re Mills gave patentable weight to functional limitations in a claim to find the claim patentable over the prior art. In re Mills, 16 USPQ2d 1430 (CAFC 1990). As stated in MPEP 2173.05(g), a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. For example, in a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as “members adapted to be positioned” and “portions . . . being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

Claim 1 recites a device for extracting a means for fixation of bone fragments at bone fractures. Griggs does not disclose or suggest this feature. Griggs is related to a compression screw assembly for applying a compressive force to a fractured bone and more specifically to a compression screw system 10 including a lag screw 20, compression plate 30 and compression screw 90 which can be assembled,

aligned and installed so that the lag screw 20 is non-rotatably secured to the compression plate 30 at the option of the surgeon (see Col. 1, lines 5-15 and Col. 3, lines 30-34). Griggs fails to disclose any device for extracting a means for fixation of bone fragments at bone fractures. Griggs merely discloses a compression screw assembly for installing the lag screw into a bone.

Further, Griggs fails to disclose an inner extraction member connectable to a pin of a fixation means, as recited in claim 1. The Examiner considers the lag screw 20 to be an inner extraction member. This is incorrect. The lag screw 20 is installed into the shaft of the fractured bone, through the fracture, and anchored in the head of the fractured bone (Col. 3, lines 34-37). The lag screw 20 is not connectable to a pin of a fixation means. In fact, since the Examiner considers the lag screw 20 to be the inner extraction member, there is no pin of a fixation means for fixation of bone fragments at bone fractures in Griggs as suggested by the Examiner.

Also, Griggs fails to disclose an outer extraction member connectable to a sleeve of a fixation means. The Examiner considers the compression plate 30 to be the outer extraction member. This is also incorrect. The compression plate 30 is non-rotatably secured to the lag screw 20 and anchored to the shaft of the bone (Col. 2, lines 5-12 and Col. 3, line 68 to Col. 4, line 5). The compression plate 30 is not connectable to a sleeve of a fixation means.

Moreover, claim 1 recites an extraction handle rotatable relative to the outer and inner extraction members in order to extract the pin in a direction of extraction. Griggs does not disclose or suggest this feature. In fact, since the Examiner considers the lag screw 20 to be the inner extraction member, there is no pin of a

fixation means that is extracted by the wrench 50 and wrench handle 58, which the Examiner considers to be the extraction handle.

Furthermore, claim 1 recites that the lengths of inner and outer extraction members and the location and shape of rotary preventing members are chosen such that an extraction handle can cooperate with the inner extraction member in order to draw the inner extraction member backwards in the direction of extraction only when the inner extraction member is inserted into the outer extraction member so that the rotary preventing members cooperate with each other. Griggs fails to disclose or suggest this subject matter. In fact, the lower shaft 52 of the wrench 50 in Griggs has a drive portion 54 on its end that is shaped to accept drive portion 24 of the lag screw 20 (See Col. 4, lines 22-30 and Figs. 19 and 20). The lag screw 20 is not required to be inserted into the compression plate 30 in order to move the lag screw 20 in any direction. Thus, claim 1 is not anticipated by Griggs. Therefore, claim 1 is allowable.

Claims 5-14 depend from claim 1 and are allowable for the same reasons as claim 1 and for the specific recitations therein.

New claim 17 patentably defines over Griggs and the other cited references for at least the following reasons.

Claim 17 recites a device for extracting a fixation assembly, which fixes bone fragments at bone fractures. Griggs does not disclose or suggest this feature. Griggs is related to a compression screw assembly for applying a compressive force to a fractured bone and more specifically to a compression screw system 10 including a lag screw 20, compression plate 30 and compression screw 90 which

can be assembled, aligned and installed so that the lag screw 20 is non-rotatably secured to the compression plate 30 at the option of the surgeon (see Col. 1, lines 5-15 and Col. 3, lines 30-34). Griggs fails to disclose any device for extracting a fixation assembly, which fixes bone fragments at bone fractures. Griggs merely discloses a compression screw assembly for installing the lag screw into a bone.

Griggs fails to disclose an inner extraction member connectable to a pin of a fixation means, as recited in claim 17. The Examiner considers the lag screw 20 to be an inner extraction member. The lag screw 20 is installed into the shaft of the fractured bone, through the fracture, and anchored in the head of the fractured bone (Col. 3, lines 34-37). The lag screw 20 is not connectable to a pin of a fixation means. In fact, since the Examiner considers the lag screw 20 to be the inner extraction member, there is no pin of a fixation means for fixation of bone fragments at bone fractures in Griggs, as suggested by the Examiner.

Also, Griggs fails to disclose an outer extraction member connectable to a sleeve of a fixation means. The Examiner considers the compression plate 30 to be the outer extraction member. The compression plate 30 is non-rotatably secured to the lag screw 20 and anchored to the shaft of the bone (Col. 2, lines 5-12 and Col. 3, line 68 to Col. 4, line 5). The compression plate 30 is not connectable to a sleeve of a fixation means.

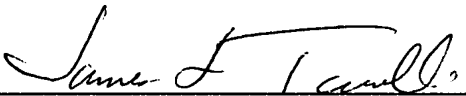
Moreover, claim 17 recites an extraction handle rotatable relative to the outer and inner extraction members in order to extract the pin in a direction of extraction. Griggs does not disclose or suggest this feature. In fact, since the Examiner considers the lag screw 20 to be the inner extraction member, there is no element of

a fixation assembly that is extracted by the wrench 50 and wrench handle 58, which the Examiner considers to be the extraction handle. Thus, claim 17 is not anticipated by Griggs and therefore, claim 17 is allowable.

In view of the foregoing, it is respectfully requested that the amendment be entered and the application allowed.

Please charge any deficiency or credit any overpayment in the fees for this matter to our Deposit Account No. 20-0090

Respectfully submitted,


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